



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/772,196

02/04/2004

Michael L. Jordan

050704/305124

4228

826

7590

06/30/2008

ALSTON & BIRD LLP

BANK OF AMERICA PLAZA

101 SOUTH TRYON STREET, SUITE 4000

CHARLOTTE, NC 28280-4000

EXAMINER

PORTER, RACHEL L

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

06/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/772,196	Applicant(s) JORDAN, MICHAEL L.	
	Examiner RACHEL L. PORTER	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. The communication is in response to the application filed 2/4/04. Claims 1-9 are pending.

Information Disclosure Statement

2. The IDS's filed 2/4/04, 5/7/04, 2/10/06, and 6/13/06, have been entered and considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hebron et al (US 2003/0066841 A1)

[Claim 1] Hebron discloses a method of discriminating between orders, comprising:

- evaluating a queue of orders based on whether each prescription within the order can be filled in an automated manner; and (Figure 9; par. 92-96)

- determining a set of workstations for each prescription based on said evaluating.
(par. 92-96)

[claim 2] Hebron discloses the method of claim 1 wherein for orders that can be filled entirely in an automated manner, said determining a set of workstations excludes a pharmacist review workstation. (par. par. 92-96)

[claim 3] Hebron teaches the method of claim 1 additionally comprising selecting an appropriate sized end user container, printing and applying a label to said container, inserting the labeled container into a carrier, and routing the carrier among the determined set of workstations. (Figure 9; par. 51, 92-94, 101)

[claim 4] Hebron discloses the method of claim 3 wherein said routing includes routing the carrier from a dispensing workstation, to an imaging workstation, and to a capping workstation. (Figure 9: par. 101-106 ; 109-111, 113]

[claim 5] Hebron discloses the method of claim 4 additionally comprising tracking multiple prescriptions that belong to one order and grouping all the prescriptions that belong to one order for shipping. (par. 16—orders accumulate for pick-up or delivery to one patient)

[claim 6] Hebron discloses the method of claim 4 additionally comprising routing the carrier to a packing workstation where a patient specific document is printed and inserted into a labeled bag along with the patient's prescription. (par.16, 51—drug order labeled with warnings and drug description documents.)

[claim 7] Hebron discloses a method of operating a prescription filling facility of the type having automated equipment and non-automated equipment for filling prescriptions, the improvement comprising identifying an order that can be filled with automated equipment and routing at least one container to be filled for said order in a manner that eliminates a review of the order by a pharmacist. (par. 11--The limitations of claim 7 are also addressed by the rejections of claims 1-6)

[claim 8] Hebron discloses the method of claim 7 additionally comprising determining a set of workstations for each prescription comprising said order identified as being fillable with automated equipment. (Figures 5-7)

[claim 9] Hebron teaches a method of operating a prescription filling line of the type having automated equipment and non-automated equipment for filling prescriptions, comprising:

- evaluating a queue of orders based on whether each prescription within each order can be filled in an automated manner; (Figure 9; par. 92-96)
- selecting an appropriate sized end user container; (Figure 9; par. 51, 92-94, 101)
- printing and applying a label to said container; (Figure 9; par. 51, 92-94, 101)
- inserting the labeled container into a carrier; (Figure 9; par. 51, 92-94, 101)
- routing the carrier to a prescription filling station; (par. 92-94, 101)
- routing the carrier to an imaging workstation; and where said order has been filled by automated equipment, routing each carrier for said order to a packing

workstation without a review by a pharmacist, (Figure 9: par. 101-106 ; 109-111, 113

- and where said order has at least one prescription filled by non-automated equipment, routing each carrier for said order to a pharmacist workstation before routing each carrier to the packing workstation. (par. 50, 90,95—steps whereby the prescription may be pulled for non-automated handling if there is a problem indicated with Rx data)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626